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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/716,397	11/20/2003	Katsuaki Akama	1086.1187	5532
21171	7590	04/14/2010	EXAMINER	
STAAS & HALSEY LLP SUITE 700 1201 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005			GYORFI, THOMAS A	
			ART UNIT	PAPER NUMBER
			2435	
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			04/14/2010	PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/716,397

**Applicant(s)**

AKAMA, KATSUAKI

**Examiner**

Thomas Gyorfi

**Art Unit**

2435

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 24 February 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-14 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/CD)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. Claims 1-14 remain for examination. The amendment filed 2/24/10 amended claims 1, 7, and 11.

### ***Continued Examination Under 37 CFR 1.114***

2. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 2/24/10 has been entered.

### ***Response to Arguments***

3. Applicant's arguments filed 2/24/10 have been fully considered but they are not persuasive. On page 8 of the amendment, Applicant primarily argues:

In Sanchez-Herrero, the HSS (home server) can correspond to the claim 1 "authentication server." In Sanchez-Herrero, from this HSS to the CSCF (call state control function), which can correspond to the claim 1 "exchange," only a response that indicates authenticated or not authenticated is transmitted from the CSCF to the HSS, and the telephone number and the terminal identification information are not transferred from HSS to the CSCF. In Sanchez-Herrero FIG. 5, the HSS does not transfer the telephone number and the terminal identification information to the CSCF. In other words, a prima facie case of obviousness based upon Sanchez-Herrero and Chander/Teitelbaum cannot be maintained, because Sanchez-Herrero fails to disclose either expressly or implicitly the claimed action of an authentication server...

Examiner disagrees. It is observed that Sanchez-Herrero teaches that in its preferred embodiment his invention is an improvement to a conventional 3G cellular network, even incorporating by reference the various standards encompassing various

aspects of that network technology (col. 8, line 60 – col. 9, line 10). Of particular interest is 3GPP standard TS 29.228, specifically dedicated to describing the content of messages exchanged between the HSS (which Examiner and Applicant agree would most likely correspond to the claimed “authentication server”) and the various CSCFs. Examiner has procured a version of TS 29.228 in which it is clearly taught that the HSS does in fact communicate significant amounts of personal information of the terminal & terminal subscriber to the CSCF during registration and de-registration procedures (see all of pages 8-23, with particular emphasis on “6.1.2 S-CSCF registration/deregistration notification”, “6.2.1 User Profile Download”, “6.3 Authentication procedures”, and “6.4 User identity to HSS resolution” etc.; see also the illustrations of Annex A4 on pages 28-32). In fact, not only is there no evidence that the contents of the messages between the HSS and CSCF of Sanchez-Herrero's invention would be substantially different from those of the standard in this respect, but to the contrary Sanchez-Herrero suggests that at least terminal subscriber information is sent by the HSS to the CSCF (col. 11, lines 40-50, in that the CSCF receives public and private IDs of the user from the HSS REGISTER message). Thus Examiner maintains that Applicant's express stipulation of an “authentication server” performing the various limitations of the claims is disclosed, or at least strongly suggested, by the current prior art of record.

***Claim Rejections - 35 USC § 103***

4. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

5. Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sanchez Herrero et al. (U.S. Patent 7,177,642) in view of Chander et al. (U.S. Patent 6,778,828).

Regarding claims 1, 7, and 11:

Sanchez Herrero discloses a method, program, and apparatus for registering the position of wireless terminal equipment (wireless disclosed at col. 5, lines 20-50 and col. 7, lines 60-67), comprising: registering in a database personal information, the personal information linking a subscribed terminal number, a terminal identification number and user charging information to biological information of a user possessing the wireless terminal equipment (the HSS: col. 8, lines 45-50); transferring subscribed telephone number and said first terminal identification information from among the personal information to an exchange which allows communication with the first wireless terminal equipment to request registration of position information permitting call in and call out of said first wireless terminal equipment by said subscribed telephone number (all of columns 10 and 11, but particularly col. 10, lines 10-30; telephone number as part of the registration at col. 4, lines 50-67); receiving from a second wireless terminal equipment an authentication request containing second terminal identification information for the second wireless terminal equipment (Ibid, but particularly col. 11, lines 15-40); retrieving personal information of the first wireless terminal equipment and updating the retrieved personal information by changing terminal information in the retrieved personal identification into the received terminal identification information (changing the active

public-ID from the first to the second device: col. 11, lines 50-65); transferring the subscribed telephone number in the retrieved personal information and the changed terminal subscriber identification information in the updated personal information to the exchange and requesting position information registration which enables call in and call out as a terminal equipment having the subscribed terminal number (col. 11, line 65 – col. 12, line 5).

Sanchez-Herrero does not disclose the use of biometric ["biological"] information as part of the process to register terminal equipment. However, Chander discloses an analogous method to register a phone to a user that links one's biometric information such as a fingerprint, to other information such as the telephone number etc. as part of a two-factor authentication scheme (col. 10, line 50 – at least col. 11, line 60). It would have been obvious to incorporate biometric information as part of the mobile phone registration process disclosed by Sanchez-Herrero, as two-factor authentication was a known improvement that was clearly within the capabilities of one of ordinary skill in the art, to achieve the predictable result of more accurately identifying the user of the terminal equipment.

Examiner takes Official Notice that Sanchez-Herrero's HSS conforms to the "authentication server" of the claims and that the messages sent between it and the CSCF would comprise the features being claimed (see Sanchez-Herrero, col. 8, line 60 – col. 9, line 10; and col. 11, lines 40-50; cf. 3GPP TS 29.228, pages 8-23)

Regarding claims 2, 8, and 12:

Sanchez-Herrero and Chander further disclose notifying a terminal equipment which has been used so far of renouncement of its use when the position information is requested of the exchange which enables call in and call out as a terminal equipment having the subscribed terminal number based on the authentication of biological information from a new terminal equipment by the received authentication request, retrieved personal information, and the transferred subscribed terminal number (Sanchez-Herrero: col. 13, lines 5-35; Chander: Ibid).

Regarding claims 3, 9, and 13:

Chander further discloses wherein the biological information received by the received authentication request is biological information read in real time into the terminal equipment (e.g. col. 11, lines 25-40).

Regarding claims 4, 10, and 14:

Sanchez-Herrero further disclose wherein the personal identification management step includes registering charged user identification information of a specific person among group members as common charged user identification of a plurality of terminal equipments owned by group members such that the specific person is charged (col. 5, lines 20-35).

Regarding claim 5:

It is now taken as Applicant admitted prior art that the wireless terminal equipment of the Sanchez-Herrero reference would likely be a cellular telephone. It is further observed that this is likely true of the Chander reference as well (preferred embodiments being GSM or other cellular terminals: col. 5, lines 50-67).

Regarding claim 6:

Chander further discloses wherein the biological information is a fingerprint, venous vascular network, palm print, palm shape, facial image, ear shape, or iris (e.g. col. 11, lines 25-40).

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas Gyorfí whose telephone number is (571)272-3849. The examiner can normally be reached on 8:30am - 5:00pm Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on (571) 272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.



For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

TAG  
4/9/10  
/Randal Moran/  
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